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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,622	02/14/2001	Frederik Ekkel	000117	2720

24737 7590 05/18/2007  
PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2144

MAIL DATE	DELIVERY MODE
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05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/784,622

Applicant(s)

EKKEL, FREDERIK

Examiner

Paul H. Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 19-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 19-21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### *Status of Claims*

1. Claims 1-11, 14-18 and 22 are cancelled. Claims 28 and 29 have been newly added.  
Claims 12, 13, 19-21 and 23-29 are now pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- a. Determining the scope and contents of the prior art.
- b. Ascertaining the differences between the prior art and the claims at issue.
- c. Resolving the level of ordinary skill in the pertinent art.
- d. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 12-13 and 19-21, 23-26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLain, US Pat. No. 6,493,758 in view of Taylor, US Patent No. 6,643,510.

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5. As per claim 1, McLain discloses the invention substantially as claimed. McLain teaches a method of providing to an individual access to the information content (McLain, col. 2, lines 26-34; the recitation regarding a “communication-restricted environment that blocks public access” is not given patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim), the method comprising:

at a terminal, providing access for an individual over an information network to a repository hosting the information content (McLain, col. 3, line 40 – col. 4, line 53);

enabling to transfer the information content over the network between the repository and a mobile storage medium (content is downloaded from the server to a user computer; McLain, col. 3, line 40 – col. 4, line 53); and

providing to the individual, access to the information content stored in the mobile storage medium, in the offline environment (The user access offline content stored in the mobile device, i.e. mobile storage medium; McLain, col. 3, line 40 – col. 4, line 53 and Taylor, Summary).

However, McLain does not explicitly teach the terminal being one of an airport, a spaceport, a boat dock, a train station, and a bus stop.

In the same field of endeavor, Taylor teaches a method of providing communication while traveling on an airplane or similar mobile platforms (See Taylor, Abstract and Summary). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a mobile platform such as an airplane and its associated computer

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devices, into the offline viewing system of McLain since airplanes are a common form for travel, suitable for a offline internet viewing system.

Further, McLain-Taylor teach assigning a traveling location to the individual in a means of transportation constituting the offline environment, the means of transportation including the mobile storage medium at said assigned traveling location (Taylor, col. 5, lines 54-67).

6. As per claim 13, McLain-Taylor discloses the information content is determined from a plurality of information contents on the basis of a profile of the individual (McLain, col. 3, line 40 – col. 4, line 53).

7. As per claim 19, McLain-Taylor discloses a method of providing information content to a passenger of an aircraft, comprising: determining the information content that is of interest to the passenger, before the aircraft departs a terminal (McLain, col. 3, line 40 – col. 4, line 53 and col. 7, line 32 – col. 8, line 36);

transferring the information content from an information network to a storage medium of the aircraft before the aircraft departs from the terminal (content is transferred to the user computer prior to accessing said data in an offline environment; McLain, col. 3, line 40 – col. 4, line 53 and col. 7, line 32 – col. 8, line 36; Taylor teaches the aircraft and associated storage device), and

providing the information content from the storage medium to the passenger while the aircraft is in flight (McLain, col. 3, line 40 – col. 4, line 53 and col. 7, line 32 – col. 8, line 36

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and Taylor, col. 5, lines 54-67).

8. As per claims 20, 21, 23, 24 and 25, McLain-Taylor discloses the step of determining the information content based on a predetermined profile that is associated with the passenger, step of transferring the information content automatically, enabling access to content and receiving information from user via network onboard, and providing a viewing device to the passenger (McLain, col. 3, line 40 – col. 4, line 53 and col. 7, line 32 – col. 8, line 36).

9. As to claim 26, McLain-Taylor teach assigning a seat to the individual in the aircraft, and, providing access to the information content at the assigned seat (Taylor, col. 5, lines 54-67).

10. As to claims 28 and 29, McLain-Taylor teach wherein said step of providing access to the information content stored in the mobile storage medium comprises providing access ports at the assigned traveling location to which the individual may connect a personal apparatus for viewing and/or listening to the information content (Taylor, col. 5, lines 54-67).

11. **Claims 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLain-Taylor, and further in view of McCarten et al., US Pat. No. 6,047,127.**

12. As to claim 27, McLain-Taylor teach the invention substantially as claimed. However, McLain-Taylor do not explicitly teach charging a fee for transferring the information content. In the same field of endeavor, McCarten teaches a electronic communication system wherein users

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are provided fee for service network access (all services provided in flight are fee for service benefits. McCarten, col. 1, line 17 – col. 2, line 17 and col. 11, lines 9-26).

*Response to Arguments*

13. Applicant's arguments with respect to claims 12-13, 19-21, 23-29 have been considered but are moot in view of the new ground(s) of rejection.

The applicants argued in substance that:

A) "The subject invention, as claimed in claim 12 includes 'at a transit terminal that includes one of an airport, a spaceport, a boat dock, a train station, and a bus stop, providing access for the individual over an information network to a repository hosting the information content', 'at the transit terminal, enabling to transfer the information content over the network between the repository and a mobile storage medium', assigning a traveling location to the individual in a means of transportation constituting the communication-restricted environment, the means of transportation including the mobile storage medium at said assigned traveling location. As such, an individual is able to select desired information at the transit terminal, send this information to a mobile storage device at the individual's assigned seating location aboard the means of transportation having a communication-restricted environment, and access this information while aboard the means of transportation using the mobile storage medium. It should be understood that the individual is not in possession of the mobile storage medium, but rather, the mobile storage medium is included in the means of transportation....In particular McLain only enables a person to access information for storage in the person's own mobile device." See Remarks, pages 6-7.

As to point A, the examiner respectfully disagrees. The recited "transit terminal" and "communication-restricted environment" will be given patentable weight to the extent a structural difference is warranted. As previously stated, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

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prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Here, using the current invention “at a transit terminal” does not affect the structure of the invention. The system of the prior art may be used at a transit terminal, airport, bus terminal, at the office, in the home, or any other place having a network connection. Likewise, a communication-restricted environment does not require a structural difference of the invention. An offline state, for purposes of practicing the invention, satisfies the scope of that limitation.

Further, as to applicants’ argument that the individual is not in possession of the mobile storage medium, but rather, the mobile storage medium is included in the means of transportation, it is noted that Taylor was relied upon for showing a storage medium on a transportation medium. Further, as to applicant’s argument that Taylor does not contemplate offline use, but rather, online use at all times, the examiner disagrees. Taylor was relied upon to show a terminal such as an airport, spaceport, a boat dock, a train station, and a bus stop. Taylor was also relied upon to show a transportation medium including a storage medium. In this case, as applicants are arguing against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

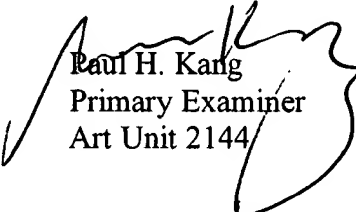
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul H. Kang  
Primary Examiner  
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